

Applic. No. 10/689,973  
Amdt. dated August 31, 2005  
Reply to Office action of June 17, 2005

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-21 remain in the application. Claims 1, 4, 8, 9, and 21 have been amended.

In item 1 on page 2 of the above-identified Office action, claims 1-21 have been rejected as being indefinite under 35 U.S.C. § 112.

More specifically, the Examiner has stated that the claims are generally narrative and indefinite and appear to be a literal translation and are replete with grammatical and idiomatic errors. It is respectfully noted that Lerner & Greenberg P.A. does not file literal translations in 35 U.S.C. § 111 applications. Furthermore, if the Examiner cites specific examples of idiomatic/grammatical errors, or where the claims are indefinite, narrative, or a literal translation, they will be considered at that time. The claims have not been amended to overcome the rejection.

The Examiner alleges that in claims 1 and 21 there is insufficient structural relationship between the elements. More specifically, the Examiner alleges that it is unclear

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what structures cause the expelling of the sheet carrying air flows during operation. Applicants respectfully disagree, the fifth paragraph of the body of claims 1 and 21 recite that the sheet-guiding surface has air passage openings formed therein for expelling said sheet-carrying air flows during operation.

Therefore, the air passage openings in the sheet-guiding surface expel the air generated by the blown-air supply system. Accordingly, it is believed that there is sufficient structural relationship in the claim. Therefore, the claims have not been amended to overcome the rejection.

The Examiner alleges that the relationship between the air passage openings, the flow ducts, and the opening cross sections is unclear. Applicants respectfully disagree with the Examiner. More specifically, the last paragraph in claims 1 and 21 recites that the air passage openings (7.1) form opening cross-sections of the flow ducts (7). The above-cited language of claims 1 and 21 is clear and definite with respect to the relationship between the air passage openings, the flow ducts and the opening cross-sections. Therefore, claim 1 and 21 have not been amended to overcome the rejection.

The Examiner stated that it is unclear what is meant by the limitation that the length is many times greater than the length. Claims 1 and 25 have been amended so as to facilitate

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prosecution of the application and now read that the length is multiple times greater than the width. Therefore, the rejection is believed to have been overcome.

The Examiner alleges that in the dependent claims 2-20, the structural relationships between the elements in these claims and the previously recited elements in claim 1 is unclear.

More specifically, the Examiner mentions that the structural relationship between the recited vanes in claim 2 and the previously recited flow ducts and cross-sections of claim 1. Applicants respectfully disagree with the Examiner. Claim 2 recites that the guide vanes are provided in the flow ducts. The above-cited language of claim 2 is clear and definite with respect to the relationship between the guide vanes and the flow ducts and the opening cross-sections. Therefore, claim 2 has not been amended to overcome the rejection.

The Examiner alleges that in claim 4 the relationship between the passage openings and the slots is unclear. Claim 4 has been amended to further clarify the claim. Similarly, claims 8 and 9 have also been amended. Therefore, the rejection of claim 4 is believed to have been overcome.

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The Examiner stated that claims 1-21 should be amended to provide proper antecedent basis. The Claims have been reviewed and are believed to have proper antecedent basis. Should the Examiner have any specific instances, it is requested that he indicate them in any subsequent Office action. Therefore, the claims have not been amended to overcome the rejection.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic or clarificatory reasons. The changes are not provided for overcoming the prior art nor for any reason related to the statutory requirements for a patent.

If the Examiner plans to repeat any of the rejections mentioned above, he is respectfully requested to first discuss them with his SPE.

In item 2 on page 3 of the Office action, claims 1-11, 14, 16-18, and 21 have been rejected as being obvious over Fujimoto

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(U.S. Patent Publication No. 2001/0011509 A1) under 35 U.S.C.

§ 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 21 call for, *inter alia*:

the air passage openings in the sheet-guiding surface forming opening cross-sections of the flow ducts, the opening cross-sections being slots having a length and a width, the length being multiple times greater than the width.

The Fujimoto reference discloses a sheet guide unit for a sheet fed press. The sheet guide unit has a guide surface (1d) with numerous vents (4a and 4b) formed therein and facing opposite directions. The vents (4a and 4b) produce two streams of air, which originate at the vents and move in directions determined by the vents. An aspiration duct (3') is provided on the edges of the guide surface (1d). The

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aspiration duct (3') is not formed in the guide surface (1d).

The air duct (3') is used to exhaust the streams of air produced by the numerous vents (4a and 4b) (page 2, paragraph 0018, and Fig. 8).

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The reference does not show or suggest the air passage openings in the sheet-guiding surface forming opening cross-sections of the flow ducts, the opening cross-sections being slots having a length and a width, the length being multiple times greater than the width, as recited in claims 1 and 21 of the instant application.

The Fujimoto reference discloses that vents are formed in the surface of a sheet guide. Aspiration ducts are disposed at the end of the guide surface. Fujimoto does not disclose that the aspiration duct is formed in the guide surface. This is contrary to the invention of the instant application as claimed, in which the air passage openings in the sheet-guiding surface form opening cross-sections of the flow ducts, the opening cross-sections being slots having a length and a width, the length being multiple times greater than the width.

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The reference applied by the Examiner does not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Furthermore, applicants respectfully disagree with the Examiner's allegation on page 4 of the Office action that "it would be obvious to one of ordinary skill in the art at the time of the invention, to provide the sheet-guiding surface (1d) of Fig. 8 with an air passage opening structure that properly controls the air flow ...". The Fujimoto reference teaches away from the Examiner's allegation. More specifically, Fujimoto discloses that "because the duct 3' is provided on the end of the guide surface, the air which is blown across the width of the sheet along the surface 1d of the sheet guide unit will be drawn into aspiration duct 3'" (page 2, paragraph 0018). Accordingly, because Fujimoto discloses that the air provided by the vents must be blown across the width of the sheet, there is no motivation to move the aspiration ducts (3') into the guide surface. In fact moving the aspiration ducts into the guide surface would destroy the function of the Fujimoto reference as disclosed because the air would not be blown across the width of the sheet. Because the modification as suggested by the Examiner

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would destroy the function of Fujimoto, there is no motivation for providing the aspiration ducts in the guide surface.

Furthermore, the air passage openings that are provided in the guide surface as recited in the instant application are provided for blowing air. This is not the case in Fujimoto, which discloses that the aspiration ducts are used to remove the air blown from the vents (4a and 4b).

Therefore, based on the above-given comments, it is respectfully believed that the Examiner's allegation that it would be obvious to one of ordinary skill in the art at the time of the invention, to provide the sheet-guiding surface (1d) of Fig. 8 with an air passage opening structure that properly controls the air flow is not correct.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious



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effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or

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suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

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Since claim 1 is believed to be allowable over Fujimoto,  
dependent claims 2-20 are believed to be allowable as well.

It is accordingly believed to be clear that none of the  
references, whether taken alone or in any combination, either  
show or suggest the features of claims 1 or 21. Claims 1 and  
21 are, therefore, believed to be patentable over the art and  
since all of the dependent claims are ultimately dependent on  
claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of  
claims 1-21 are solicited.


In the event the Examiner should still find any of the claims  
to be unpatentable, counsel respectfully requests a telephone  
call so that, if possible, patentable language can be worked  
out.

If an extension of time for this paper is required, petition  
for extension is herewith made.

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Please charge any other fees which might be due with respect  
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &  
Greenberg P.A., No. 12-1099.

Respectfully submitted,

  
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For Applicant(s)

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AKD:cgm

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